

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

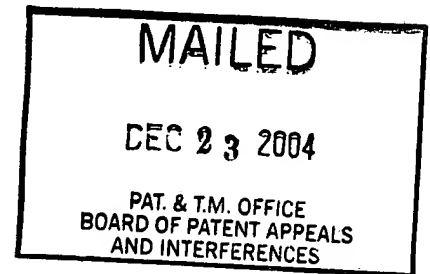
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CATHERINE M. KEENE, RAYMOND LIN and RAO SADHURREDY

Appeal No. 2004-2070
Application No. 09/401,251

ON BRIEF



Before JERRY SMITH, DIXON, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

REMAND TO THE EXAMINER

We remand this application to the Examiner for consideration of the following matters.

- I. Whether a rejection of claims 1-6 and 15 under 35 U.S.C. § 112, second paragraph is appropriate.
- II. Whether a rejection of claims 1-16 under 35 U.S.C. § 112, first paragraph is appropriate.
- III. How the Thorsen patent meets the limitations of claims 1-16 in the rejections under 35 U.S.C. § 102 and § 103.

***I. Whether A Rejection Of Claims 1-6 and 15 Under
35 U.S.C. § 112, Second Paragraph Is Appropriate.***

Independent claims 1, 15, and their dependent claims recite or depend from claims that do not make grammatical sense.

Claim 1, line 2 does not make grammatical sense.

Claim 1, lines 15-16, the clauses that begin "that was set up . . ." and "that may be viewed . . ." each reference some other item in the claim. It is unclear what item is being referenced.

Claim 1, line 16, the clause "on the user computer system" is disconnected from whatever is being referenced by this clause.

Claim 16, lines 12 and 14 do not make grammatical sense.

As we are unable to determine with certitude the meaning of these sections of these claims, we are not able to determine the scope of these claims. The record before us does not mention nor address this in any way. Therefore, we request that the Examiner take appropriate steps to address this issue.

Accordingly, we *remand* for consideration of this issue.

II. Whether A Rejection Of Claims 1-16 Under 35 U.S.C. § 112, First Paragraph Is Appropriate.

Independent claims 1, 7, and 13-16, and their dependent claims recite or depend from claims that recite, "a version of an object" or "a version of the object," and specific features of that version. We have reviewed Appellants' specification as originally filed and find subject matter in the claims before this Board that fails to comply with the written description requirement. The claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

The specification describes the attributes and features of a version of an object in the specification at page 20, lines 9-18. This description shows that the version includes "modification privileges" as claimed in claims 3-5. However, this description in no way indicates that the version includes access privileges or access criteria associated with the version. Rather, these access features are present in the original object, the description of which comprises the remainder of Appellants' specification.

Appellants' original claims were directed to the features of the "original object." The claims were subsequently amended to cover the "version of the object." However, the claims were not further amended to remove those features that were disclosed as being found in the "original object" and were not disclosed as being found in the "version of the object" created from the data in the original object. The specification shows that the access criteria define a user's scope of access to the original object when a version of an object is created for that user, and the user has complete access to the version once it is created.

The record before us does not mention nor address this in any way. Therefore, we request that the Examiner take appropriate steps to address this issue.

Accordingly, we *remand* for consideration of this issue.

III. How the Thorsen patent meets the limitations of claims 1-16 in the rejections under 35 U.S.C. § 102 and § 103.

The rejections include a lengthy discussion citing substantial sections of the Thorsen patent as corresponding to sections of Appellants' claims. However, the rejection does not point out how numerous features within the sections of the claims are met by specific features within the cited sections of the Thorsen patent. We point out examples from claims 1 and 13 as exemplary of all the claims.

Claim 1, the rejection fails to indicate what in the Thorsen patent corresponds to "the object comprising distinguishable groups of data," "each group having associated access criteria," "a document file," "set up and send a document file," "associated documents stored in the database," "a version of an object," and "groups of data contained within a version of an object."

Claim 13, the rejection fails to indicate what in the Thorsen patent corresponds to "varying formats," "an object," "a version of an object," and "a redacted document."

The features mentioned above with respect to claims 1 and 13 are exemplary only. We note that a rejection based on the prior art should indicate how every feature of a claim is met by that prior art. See MPEP 707:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable**. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (Emphasis added)

We recognize that where the cited section of the prior art is identical to the claimed feature, no further explanation is

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usually needed. However, we find that this is not the situation before us.

The record before us does not address numerous features in the claims in any meaningful way. Therefore, we request that the Examiner take appropriate steps to address this issue.

Accordingly, we *remand* for consideration of this issue.

Conclusion

If reconsideration by the examiner does not promptly result in the withdrawal of all pending rejections, the examiner must return this application to the jurisdiction of the Board so that the appeal may be restored to its existing place in the order in which appeals are decided. In the event that the examiner returns this application to the jurisdiction of the Board following reconsideration, a new appeal number will be assigned. However, a new appeal fee will not be required.

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This application, by virtue of its Special status, requires ***immediate*** action by the examiner. See MPEP § 708.01(d). The Board of Patent Appeals and Interferences ***must*** be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

REMAND TO THE EXAMINER

Jerry Smith
JERRY SMITH

JERRY SMITH
Administrative Patent Judge

JOSEPH L. DIXON

JOSEPH L. DIXON /
Administrative Patent Judge

Ellen R. MacDonald

ALLEN R. MACDONALD
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